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Patent and Trademark Office

NOTICE OF ALLOWANCE AND ISSUE FEE DUE

IM31/0801

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APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
09/119,187	07/20/98	016	LEADER, W	1741 08/01/00
First Named Applicant	WARREN, 35 USC 154(b) term ext. = 0 Days.			

TITLE OF INVENTION METHOD FOR CREATING AND TESTING A COMBINATORIAL ARRAY EMPLOYING INDIVIDUALLY ADDRESSABLE ELECTRODES

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
1 98-15	205-081.000	016	UTILITY	NO	\$1210.00	11/01/00

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.

THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.

HOW TO RESPOND TO THIS NOTICE:

- I. Review the SMALL ENTITY status shown above.
If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:
 - A. If the status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or
 - B. If the status is the same, pay the FEE DUE shown above.
- If the SMALL ENTITY is shown as NO:
 - A. Pay FEE DUE shown above, or
 - B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.
- II. Part B-Issue Fee Transmittal should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B Issue Fee Transmittal should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "4b" of Part B-Issue Fee Transmittal should be completed and an extra copy of the form should be submitted.
- III. All communications regarding this application must give application number and batch number.
Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/119,187 07/20/98 WARREN

C 98-15

IM31/0801

RONALD A KRASNOW
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EXAMINER

LEADER IN

ART UNIT

PAPER NUMBER

1741

DATE MAILED:

08/01/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

NOTICE OF ALLOWABILITY

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

- ☒ This communication is responsive to the paper filed 6/26/00 with a COM dated 6/26/00
☒ The allowed claim(s) is/are 19-22, 24 and 38-48
☒ The drawings filed on 07/08/00 are acceptable.

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR REPLY to comply with the requirements noted below is set to EXPIRE THREE MONTHS FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

☐ Applicant MUST submit NEW FORMAL DRAWINGS

☐ because the originally filed drawings were declared by applicant to be informal.

☐ including changes required by the Notice of Draftsperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. _____

☐ including changes required by the proposed drawing correction filed on _____, which has been approved by the examiner.

☐ including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any reply to this notice should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Interview Summary, PTO-413

☒ Examiner's Amendment/Comment

☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

☐ Examiner's Statement of Reasons for Allowance

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An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Eric Dobrusin on July 26, 2000.

In the Title: /

"System And" has been deleted.

In the Specification: /

Page 2, line 30: -- , now U.S. patent 5,985,356, -- has been inserted after "08/327,513".

In the Claims: /

Claim 19, line 2: "electrode arrays" has been changed to --electrodes comprising an array--.

Claim 19, line 10: "arrays" has been changed to --electrodes--.

Claim 20, line 1: "19" has been changed to --38--.

Claim 20, line 6: "predetermined locations" has been changed to --given

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electrode--.

Claim 24, line 2: "an" has been inserted after "includes".

Claim 38, line 2: "plurality" has been changed to --mixture--.

Claim 39, line 1: --methanol oxidation-- has been inserted after "catalytic".

Claim 40, line 2: "electrode arrays" has been changed to --electrodes

comprising an array--.

Claim 41, line 2: "electrode arrays" has been changed to --electrodes

comprising an array--.

Claim 41, line 14: "catalytic activity" has been deleted.

Claim 44, line 1: "19, 40 or 41, wherein said depositing step includes" has been changed to --43,--.

Claim 44, line 2: "changing" has been changed to --wherein said automated system changes".

Claim 45, line 1: "step includes" has been changed to --steps include--.

Claim 46, line 1: "depositing step" has been changed to --depositing steps--.

Claim 46, line 2: "include" has been changed to -- include--.

Claim 47, line 1: "19" has been changed to --38--; "step includes" has been changed to --steps include--.

Claim 48, line 1: "step includes" has been changed to --steps include--.

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COMMENTS

These changes have been made to bring the title into conformance with the claimed subject matter which is exclusively directed to a method, to add the current data for application serial number 08/327,513 to the specification, and to more clearly claim the invention. Line 2 of the preambles of independent claims 19, 40 and 41 have been amended to change the reference to "electrode" (singular) "arrays" (plural) to --electrodes comprising an array-- to agree with other lines of the claims which refer to "electrodes" in the plural and "array" in the singular. The dependency of claim 20 has been changed from claim 19 to claim 38. Claim 20 refers to the step of delivering "said mixture". However, in the amendment of February 8, 2000, applicant deleted the recitation of a mixture from claim 19. Consequently, the dependency of claim 20 has been changed to claim 38 which, as presently amended, recites a mixture of source materials. The dependency of claim 47 has similarly been changed. In claim 39, the scope of the expression "catalytic activity" was not clear because it was not apparent what different types of activity were to be included. Consequently, claim 39 has been amended to refer to a specific activity, --catalytic methanol oxidation activity--. Basis is found in the example beginning on page 11 of the specification. The dependency of claim 44 has been changed to claim 43. Claim 44 now recites that the automated system recited in claim 43 changes the deposition locations. Basis is found at page 8, line 24 to page

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9, line 17 of the specification. In claims 45 through 48, reference to "said depositing step" (singular) has been changed to -- said depositing steps-- (plural) because each of the independent claims on which claims 45-48 depend, recite a plurality of depositing steps rather than a single step. In claim 19, step "c)" step is a depositing step. Step "d)" recites performing steps "b)" and "c)" at a *plurality* of different electrodes. Claim 40 and 41 recite "repeating said depositing step".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Leader, whose telephone number is (703) 308-2530. The examiner can normally be reached Mondays-Fridays from 7:30 AM to 3:00 PM eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathryn Gorgos can be reached at (703) 308-3328. The fax phone number for *official* after final faxes is (703) 305-3599. The fax phone number for all other *official* faxes is (703) 305-7718. Unofficial communications to the Examiner should be faxed to (703) 305-7719.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

William Leader:wtl
July 31, 2000


Kathryn Gorgos
Supervisory Patent Examiner
Technology Center 1700



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Applicant(s): Warren et al
Serial Number: 09/119,187
Filing Date: 7-20-98
Title: Method of Creating and Testing a
Combinatorial Array Employing Individually
Addressable Elements

NOTICE OF INFORMAL APPLICATION

(Attachment to Office Action)

This application does not conform with the rules governing applications for the reason(s) checked below. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A. A new oath or declaration, identifying this application by the serial number and filing date is required. The oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ was not executed in accordance with either 37 CFR 1.66 or 1.68.
2. ☐ does not identify the city and state or foreign country of residence of each inventor.
3. ☐ does not identify the citizenship of each inventor.
4. ☐ does not state whether the inventor is a sole or joint inventor.
5. ☐ does not state that the person making the oath or declaration:
 - a. ☐ has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. ☐ believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
 - c. ☐ acknowledges the duty to disclose information which is material to the examination of the application in accordance with 37 CFR 1.56(a).
6. ☐ does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
7. ☐ does not state that the person making the oath or declaration acknowledges the duty to disclose material information as defined in 37 CFR 1.56(a) which occurred between the filing date of the prior application and filing date of the continuation-in-part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).
8. ☐ does not include the date of execution.
9. ☐ does not use permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a) for the: ☐ signature ☐ oath/declaration.
10. ☒ contains non-initialed alterations (See 37 CFR 1.52(c) and 1.56). -Inventor McFarland.
11. ☐ does not contain the clause regarding "willful false statements..." as required by 37 CFR 1.68.
12. ☐ Other:

B. Applicant is required to provide:

1. ☐ A statement signed by applicant giving his or her complete name. A full name must include at least one given name without abbreviation as required by 37 CFR 1.41(a).
2. ☐ Proof of authority of the legal representative under 37 CFR 1.44.
3. ☐ An abstract in compliance with 37 CFR 1.72(b).
4. ☐ A statement signed by applicant giving his or her complete post office address (37 CFR 1.33(a)).
5. ☐ A copy of the specification written, typed, or printed in permanent ink, or its equivalent in